

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH GRAJEWSKI
and
DOUGLAS JAEGER

Appeal No. 2006-0775
Application No. 09/356,940

ON BRIEF

Before HAIRSTON, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 33 through 54.

The disclosed invention relates to a method and device for storing indicia representative of a secured site, and for randomly generating a password uniquely associated with the indicia.

Claims 33 and 45 are illustrative of the claimed invention, and they read as follows:

33. A device for use by an authorized individual having a unique biometric parameter to obtain information for use in accessing a secured site, the device comprising:

- a. a portable body member;
- b. a biometric interface unit engaged with said body member;
- c. a non-volatile memory mounted to said body member;
- d. biometric circuitry for generating and storing in said non-volatile memory an initialized biometric template upon presentment of the person's unique biometric parameter to said biometric interface unit, and generating a second biometric template upon subsequent presentment of the person's unique biometric parameter to said biometric interface unit;
- e. compare circuitry for enabling said device only if said second biometric template is substantially identical to said initialized biometric template;
- f. a data storage source;
- g. user interface and communication componentry for permitting said individual to store in said data storage source a plurality of indicia each one of which is representative of a secured site; and
- h. password circuitry for generating a plurality of passwords, wherein each of said plurality of passwords is uniquely associated with a respective one of said plurality of indicia in sequence.

45. A device for use by an authorized individual to obtain information for use in accessing a secured site, the device comprising:

- a. a portable body member;
- b. a data storage source contained in said body member;
- c. user interface and communication componentry for permitting said individual to store in said data storage source a plurality of indicia each one of which is representative of a secured site; and
- d. password circuitry comprising a random number generator for randomly generating a plurality of passwords, wherein each of said plurality of passwords is uniquely associated with a respective one of said plurality of indicia in sequence.

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The references relied on by the examiner are:

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| Noll et al. (Noll) | 5,732,138 | Mar. 24, 1998 |
| He | 5,944,824 | Aug. 31, 1999 (filed Apr. 30, 1997) |
| Bang | 6,088,143 | July 11, 2000 (filed Jan. 23, 1998) |
| Guthrie et al. (Guthrie) | 6,161,185 | Dec. 12, 2000 (filed Mar. 6, 1998) |
| Ramachandran 2001 1998) | 6,315,195 | Nov. 13, (effective filing date Apr. 17, |
| McIntosh (U.K. Patent Application) | 2 274 184 | July 13, 1994 |

Claims 33 through 52 stand rejected under the first paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement.

Claims 45 through 48 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of He.

Claims 45 through 48 and 53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of Noll.

Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of He and Bang.

Claims 50 through 52 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of He and Guthrie.

Claims 33 through 36 and 38 through 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of He and Ramachandran.

Claim 37 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of He, Ramachandran and Bang.

Claims 42 through 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McIntosh in view of He, Ramachandran and Guthrie.

Reference is made to the July 9, 2003 Office Action, the answer and the briefs for the respective positions of the examiner and the appellants

OPINION

We have carefully considered the entire record before us, and we will sustain the lack of written description rejection of claims 33 through 52, reverse the obviousness rejections of claims 45 through 48 and 53, and sustain the obviousness rejections of claims 33 through 44, 49 through 52 and 54.

Turning first as we must to the lack of written description rejection, the appellants argue (brief, page 14) “[t]he language in the claim clearly recites “*each* of said plurality of passwords is uniquely associated with a respective *one* of said plurality of indicia,” and “[t]he only reasonable interpretation of this language is that the claimed invention associates each password with one indicia, and not all of the passwords with all of the indicia all at once.” The examiner is of the opinion (answer, pages 4 and 5) that the scope of the claims on appeal covers the storage

of a plurality of indicia prior to generating the passwords that are then associated with the indicia all at once and in sequence, whereas the originally filed disclosure “describes a process of storing a single indicia, generating a single password, and then associating that single password with that indicia.” The examiner concludes (answer, pages 4 and 5) “[w]hile, according to the original disclosure, the process can be repeated for additional indicia one at a time (i.e., in series; refer to specification page 7, top paragraph), the original disclosure does not support associating plural passwords with plural indicia all at once (i.e., in parallel).”

We agree with the examiner’s position. The claims as drafted clearly state that a “plurality of indicia” is stored in the data storage source prior to the generation of the plurality of passwords, whereas the originally filed disclosure specifically discloses that a single indicia is stored, and then an associated password is generated (specification, page 7; Figure 4). After all of the indicia are stored, and all of the passwords are generated, then “each” of the plurality of passwords in the claims on appeal is uniquely associated with a respective “one” of the plurality of indicia in sequence. Thus, the lack of written description rejection is sustained because the originally filed disclosure does not provide support for claims 33 through 52 on appeal.

Turning next to the obviousness rejection of claims 45 through 48 and 53 based upon the teachings of McIntosh and either He or Noll, appellants and the examiner agree that McIntosh does not disclose “password circuitry comprising a random number generator for randomly generating a plurality of passwords” (answer, page 7; brief, pages 5 and 6; reply brief, page 4).

In McIntosh, the user of the system creates a password by inputting a sequence of letters into memory. The sequence of letters corresponds to a sequence of numbers. During access of the password, the user of the system inputs the sequence of letters, and the memory provides the sequence of corresponding numbers to a display. If the user inputs an incorrect sequence of letters during the access operation, then a random number generator will display a random number (Abstract; McIntosh, page 2, lines 1 through 6; page 3, lines 6 through 15; page 4, lines 21 through 46). Although He and Noll are directed to the use of a random number generator during the operation of creating a password, as opposed to during the operation of accessing a password as in McIntosh, the examiner concludes (answer, page 8) that it would have been obvious to one of ordinary skill in the art “to add a random password generating circuit, or to modify the password circuitry already disclosed by McIntosh.” Appellants argue that the purported motivation (i.e., increased security, convenience and uniqueness of a random password) for modifying McIntosh with the teachings of either He or Noll is insufficient to support the structural redesign of McIntosh from a device that stores previously existing passwords into a device that is capable of generating a password (brief, page 7; reply brief, page 7). If such a modification is made to McIntosh, then the redesign will impermissibly change the principle operation of the McIntosh device (brief, page 11; reply brief, page 7). Based upon the teachings of the references, the appellants argue (brief, page 10) that the examiner has used the appellants’ own teachings in an impermissible hindsight analysis.

We agree with appellants' arguments. Even if we assume for the sake of argument that a random password has advantages over a non-random password, the examiner's rejection lacks a cogent explanation as to how the applied references teach or would have suggested to the skilled artisan the use of a random number generator to generate a password as well as access a password. As indicated supra, McIntosh uses a random number generator during access of a password, whereas He and Noll only use a random number generator during the generation of a password. If the proposed modification is made, will the random number generator be used during the generation as well as the access phases of operation in McIntosh? More importantly, will the modified McIntosh device operate as it was originally intended to operate? Thus, in the absence of a convincing line of reasoning for applying the teachings of He and Noll to McIntosh, we hereby agree with the appellants that the examiner has resorted to impermissible hindsight to demonstrate the obviousness of claims 45 through 48 and 53. The obviousness rejections of claims 45 through 48 and 53 are reversed.

Turning next to the obviousness rejections of claims 33 through 44, 49 through 52 and 54, we find that appellants have not presented any arguments to refute the examiner's obviousness positions (pages 19 through 25 of the July 9, 2003 Office Action). In view of appellants' grouping of the claims (brief, page 4), and appellants' failure to present separate patentability arguments for the noted claims, we hereby sustain the obviousness rejections of claims 33 through 44, 49 through 52 and 54.

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DECISION

The decision of the examiner rejecting claims 33 through 52 under the first paragraph of 35 U.S.C. § 112 is affirmed, and the decision of the examiner rejecting claims 33 through 54 under 35 U.S.C. § 103(a) is affirmed as to claims 33 through 44, 49 through 52 and 54, and is reversed as to claims 45 through 48 and 53.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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